

REMARKS

Applicant wishes to thank the Examiner for the attention accorded to the instant application, and respectfully requests reconsideration of the application as amended.

Formal Matters

In this amendment, claims 1, 3, 6, 7, 12, 13, 15, and 18-27 are amended herein to more clearly recite the invention and to make minor editorial corrections. Claims 1 and 25 are further amended to include the limitations of claims 2 and 4 which are canceled herein. Similarly, claim 3 is further amended to include the limitations of claim 5 which is canceled herein, claim 13 is further amended to include the limitations of claims 14 and 16 which are canceled herein, and claim 15 is further amended to include the limitations of claim 17 which is canceled herein.

Applicant thanks the Examiner for acknowledging receipt of papers submitted under 35 U.S.C. 119 (a)-(d), and for review and consideration of the references cited in the Information Disclosure Statement filed with the application on September 12, 2003, and the Information Disclosure Statement filed June 24, 2005. Applicant respectfully requests that the Examiner review and consider the references cited in the Information Disclosure Statement filed January 18, 2006.

Specification

In the specification, the paragraph beginning on page 18, line 8 has been amended to make minor editorial corrections.

Drawings

A replacement Figure 6 is submitted herewith; it has been amended to make minor corrections.

Rejection of Claims Under 35 U.S.C. §103

Claims 1-27 are rejected under 35 U.S.C. § 103(a) as unpatentable over over Heinonen et al., U.S. Patent No. 6,744,753, (hereinafter “Heinonen”) in view of Seazholtz et al., U.S. Patent No. 5,790,952 (hereinafter “Seazholtz”). This rejection should be withdrawn based on the comments and remarks herein.

The present invention provides an inventive solution to the problem that a conventional mobile phone equipped with a function for local wireless communication must maintain one of three connection states: one, connected to a headset, two, connected to a local wireless communication device, or three, waiting for connecting instructions from a local wireless communication device, i.e. being in a waiting state. The solution to this problem is provided by an inventive mobile phone and method in which it is unnecessary to be in one of these three states, thus providing flexibility to a user of the phone, and suppressing wasteful power dissipation. The inventive mobile phone has a memory in which a plurality of local wireless communication devices and an awaiting state are registered, the devices and the awaiting state each having a predetermined priority order, and, when an incoming call is detected, a connection request is transmitted, in priority order, to either the awaiting state, or to one of the plurality of local wireless communication devices registered in the memory of the mobile phone. Thus, a user of this inventive mobile phone can achieve battery protection, and can use various wireless communication devices with this mobile phone, without connecting a specific wireless communication device or placing the phone in a waiting state prior to the mobile phone's use for talking or data communication.

The Examiner states that Heinonen does not specifically disclose the feature of an awaiting state (see Office Action, page 3, lines 2-6). Seazholtz does not overcome this

deficiency. Seazholtz discloses a control system for a plurality of participating radio telephone subscriber units, where the system includes means for broadcasting on a cellular digital packet channel, a list of identifying numbers for each service provider operating within a range of the means for broadcasting (column 8, lines 45-50). More than one signal identification number (SID) can be selected and stored in a standard cellular handset, and priority can be assigned within the pre-stored preferred SID list (column 10, lines 9-10, column 13, lines 66-67, column 14, lines 59-60). However, Seazholtz does not disclose or suggest registering an awaiting state in addition to the SID. Thus the hypothetical combination of Heinonen and Seazholtz does not suggest a memory that registers a plurality of devices and also registers an awaiting state in accordance with a priority order, as recited in independent claims 1, 3, 12, 13, 15, and 24-27.

It has been held by the courts that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. See, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). As illustrated above, the hypothetical combination of Heinonen and Seazholtz does not disclose or suggest each and every feature of the present invention as recited in the independent claims. Claims 8 and 10 depend from claim 1, claims 7, 9 and 11 depend from claim 3, claims 18, 20 and 22 depend from claim 13, and claims 19, 21 and 23 depend from claim 15, each dependent claim incorporating all of the features and limitations of its respective base claim. Thus these dependent claims are patentable over the art of record in the application for at least the reason that their base claims are patentable over the art of record in the application.

CONCLUSION

For at least the reasons set forth in the foregoing discussion, Applicant believes that the application is now allowable and respectfully requests that the Examiner reconsider the rejections and allow the application. Should the Examiner have any questions regarding this Amendment, or regarding the Application generally, the Examiner is invited to telephone the undersigned attorney.

Respectfully submitted,



Katherine R. Vieyra
Registration No. 47,155

SCULLY, SCOTT, MURPHY & PRESSER, P.C.
400 Garden City Plaza – Suite 300
Garden City, New York 11530
(516) 742-4343 (telephone)
(516) 742-4366 (facsimile)

KRV:vh